

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GREGORY McDONALD and PATRICK WHEELER

MAILED

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2005-1930
Application No. 09/368,045

ON BRIEF

Before BARRETT, BLANKENSHIP, and NAPPI, **Administrative Patent Judges**.

NAPPI, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 1, 13 through 16, 18, 20, 22, 23, 30, 31, 33 through 36, 44 through 48, 51, 55 through 79 and 82 through 85 which constitute all the claims remaining in the application. For the reasons stated *infra* we will not sustain the examiner's rejection of claims 1, 13 through 16, 18, 20, 22, 23, 30, 31, 33 through 36, 44 through 48, 51, 55 through 79 and 82 through 85.

THE INVENTION

The invention relates to a system of automatic bill payment that reduces the telephone traffic to customer service representatives by automating functions of the bill payment service. See page 2 of appellants' specification.

Claim 1 is representative of the invention and is reproduced below:

1. A method of bill payment service for a customer, comprising:
 - receiving identification information for the customer by a retail system application in response to an automatic prompt of the customer by the retail system application;
 - automatically verifying the identification information by the retail system application and handing off the customer and the identification information to a bill payment application;
 - receiving a customer selection of one of a touch tone mode and a voice mode of communication in response to an automatic prompt by the bill payment application;
 - receiving a customer selection of a bill payment option from a group of bill payment options consisting of a recurring bill payment option, an add or change payee for bill payment option, a single bill payment option, and a status, change or cancel bill payment option, in response to an automatic prompt by the bill payment application;
 - automatically, non-optionally handing off the customer to a customer service representative by the bill payment application for a non-automated verification of the customer's identification by the customer service representative at a telephone as a security measure, if the customer selection is received for one of the recurring bill payment option and the add or change payee for bill payment option;
 - receiving a customer selection of an option to designate a payee from one of a customer-specific payee identification list of the customer and a common payee list provided by the bill payment application, in response to an automatic prompt by the bill payment application;

receiving a customer selection of an option to designate the payee by one of entering a payee ID by the customer from the customer-specific payee identification list and selecting the payee from the customer-specific payee identification list spoken by the bill payment application, if the option to designate the payee from the customer-specific payee identification list is received;

receiving information about a payment amount for at least one bill payment for the customer by the bill payment application in response to an automatic prompt by the bill payment application;

receiving information about a payment date for the bill payment by the bill payment application in response to an automatic prompt by the bill payment application;

automatically scheduling the bill payment by the bill payment application for the customer according to the bill payment information;

receiving a confirmation of the payee, the payment amount, and the payment date for the scheduled bill payment application in response to an automatic prompt by the bill payment application; and

rendering the scheduled bill payment to the payee by the bill payment application for the customer by one of a check and an electronic transfer of funds to the designated payee on the payment date indicated by the customer.

THE REFERENCES

The reference relied upon by the examiner are:

Lawlor et al. (Lawlor)	5,220,501	Jun. 15, 1993
Porter et al. (Porter)	5,825,856	Oct. 20, 1998
Transue et al. (Transue)	5,893,902	Apr. 13, 1999

THE REJECTION AT ISSUE

Claims 1, 13 through 16, 18, 20, 22, 23, 30, 31, 33 through 36, 44 through 48, 51, 55 through 79 and 82 through 85 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Transue in view of Lawlor and Porter.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejection and the arguments of appellants and the examiner, for the reasons stated *infra* we will not sustain the examiner's rejection of claims 1, 13 through 16, 18, 20, 22, 23, 30, 31, 33 through 36, 44 through 48, 51, 55 through 79 and 82 through 85 under 35 U.S.C. § 103(a).

Appellants argue, on page 7 of the brief, that Transue does not teach the claimed step of:

[A]utomatically, non-optionally handing the customer off to a service representative for non-automated verification of the customer's identification as a security measure on receipt of the customer's selection of the recurring bill payment or add or change payee options according to Applicants' claimed invention, but instead connects the customer to a customer service representative only upon selection by the customer of an option to speak with the customer service representative.

Similarly, on page 8 of the brief, appellants argue that Lawlor does not teach the step, rather appellants argue:

Lawlor et al. do not even employ a customer service representative, but instead the customer is required to enter his or her ATM personal identification number (PIN), and Lawlor et al. relies solely on terminal possession and knowledge of the customer's PIN to authenticate the customer's identity.

Further, on pages 8 and 9 of the brief, appellants argue:

Porter et al. do not teach or suggest automatically, non-optionally handing the customer off to a service representative for non-automated verification of the customer's identification as a security measure on receipt of the customer's selection of the recurring bill payment or add or change payee options according to Applicants' claimed invention, but instead require the customer to select the option to speak to a customer service representative. Alternatively, Porter et al. may connect the customer to a customer to a customer service representative in the event of a timeout or customer error. See, e.g., Col. 5, lines 35-45; Col. 5, lines 47-63; Col. 7, lines 1-15; Col 8, lines 13-19.

On pages 4, and 5 of the Answer, the examiner asserts that Porter was relied upon for the teaching if the non-optinal handoff, referring to page 5 of the prior Office Action. On page 5 of the Office Action dated December 30, 2003, the examiner states:

Porter discloses elements of automatically, non-optionally handing off the customer to a customer service representative by the bill payment

application for a non-automated verification of the customer's identification by the customer service representative at a telephone as a security measure (Fig. 3B, eles. 234, 235, 226 and related text; Col. 9, lines 34-45) and customer selection for one of the recurring bill payment option and the add or change payee for bill payment option (Fig. 14, eles, 638, 640, 641; Figs. 15A and 15B).

We disagree with the examiner's rationale. Claim 1 includes the limitation of "automatically, non-optionally handing off the customer to a customer service representative by the bill payment application for a non-automated verification of the customer's identification by the customer service representative at a telephone as a security measure, if the customer selection is received for one of the recurring bill payment option and the add or change payee for bill payment option." Independent claims 75, 82, 84 and 85 contain similar limitations. We find that the scope of this limitation requires the customer or user of the bill payment service to be handed off to a customer service representative if the customer selects either recurring bill payment option or change payee option. We do not find that the Porter teaches handing off the customer to a customer service representative if either of these options is selected. Porter's steps 234, 235 and 226, of figure 3B teach handing the customer off to a customer service representative if the caller enters a blocked Customer Identification Number (CIN). See column 7, lines 1 through 11. Porter's steps 638, 640 and 641, in figure 14, teach prompting the user to determine if the user desires to enroll in the bill payment system, if the user so desires, the user is handed off to a customer service representative. See step 637 and 638 of figure 14, see also column 20, lines 31 though 38. We do not find that a blocked CIN or a request

Appeal No. 2005-1930
Application No. 09/368,045

to enroll in the bill payment system meet either of the claimed customer selection of recurring bill payment option or change payee option. Porter does teach that as part of the bill payment program the user can be prompted to initiate a recurring bill. See figure 15B step 673 and 674, see also column 22, lines 8 through 14. However, we do not find a teaching in Porter, that the customer is automatically, non-optionally connected to a customer service representative based upon this selection. As the examiner has not asserted, nor do we independently find, that Transue or Lawlor teach this limitation, we find that the combination of the references fails to teach all of the limitations of independent claims 1, 75, 82, 84 and 85. Accordingly, we will not sustain the examiner's rejection of claims 1, 13 through 16, 18, 20, 22, 23, 30, 31, 33 through 36, 44 through 48, 51, 55 through 79, 82, 84 and 85.

We next consider independent claim 83. Independent claim 83 does not include the limitation of "automatically, non-optionally handing off the customer to a customer service representative by the bill payment application ..." as discussed *supra*. Claim 83 includes the limitations "establishing a common payee list on the bill payment application; establishing a customer-specific payee list on the bill payment application according to information provided by the customer."

Appellants argue, on page 6 of the brief, "Transue et al. do not teach or suggest receiving the customer's selection of the option to designate a payee from either a customer-specific payee identification list of the customer or a common payee list of the bill payment application." On pages 7 and 8 of the

Appeal No. 2005-1930
Application No. 09/368,045

brief, appellants present similar arguments directed to Lawlor, arguing that Lawlor “instead require the user to provide a pre-specified biller list in advance from which the user can enter a selection.” On page 8 of the brief, appellants present a similar argument that Porter does not teach the limitation.

In response the examiner states, on pages 3 and 4 of the answer: “*Transue discloses a customer specific payee identification list at Fig. 2, and Col. 4, lines 21-40. Additionally, Lawlor discloses the limitation of a common payee list a [sic] noted in the prior Office Action at mid-page 4.*” On page 4 of the Office Action dated December 30, 2003, the examiner states, “Lawlor et al disclose a common pre-selected list at Col. 10, lines 44-53 and a customer-specific payee identification list at Col. 33, lines 3-22.”

We disagree with the examiner’s findings. Lawlor teaches, in column 10 lines 47 and 48, “[t]he list of payees the user selects can be anyone, not a preselected list,” further in column 33 lines 3 through 21, Lawlor discusses a user unique list of payers. Thus, we do not find that Lawlor teaches a common payee list as asserted by the examiner. Further, Transue, teaches in column 4, lines 26 through 29, presenting the user with a user selected list of merchants to pay. Thus, we do not find that the combination of Lawlor or Transue teach the claim limitation of “establishing a common payee list on the bill payment application; establishing a customer-specific payee list on the bill payment application according to information provided by the customer” as recited in claim 83. The examiner has not asserted, nor do we find that Porter teaches this limitation. Accordingly, we will not sustain the examiner’s rejection of claim 83.

Appeal No. 2005-1930
Application No. 09/368,045

In summary, We will not sustain the examiner's rejection of claims 1, 13 through 16, 18, 20, 22, 23, 30, 31, 33 through 36, 44 through 48, 51, 55 through 79 and 82 through 85 under 35 U.S.C. § 103(a). The decision of the examiner is reversed.

REVERSED

Lee E. Barrett
LEE E. BARRETT
Administrative Patent Judge)

Howard B. Blankenship
HOWARD B. BLANKENSHIP
Administrative Patent Judge)

~~Robert E. Nappi~~
ROBERT E. NAPPI
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Appeal No. 2005-1930
Application No. 09/368,045

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